

REMARKS

Claims 1-20 are currently pending in the Application. Claims 1, 3, 5-6, 8-11, 13-14, and 17-18 are currently amended to clarify the claimed subject matter(s), without acquiescence in the cited basis for rejections or prejudice to pursue the original claims in a related application. No new matter has been added.

I. Allowable Subject Matter

Applicants wish to thank the Examiner for finding claims 1-20 to be allowable over the prior art of record. With respect to the reasons for allowability as stated in the August 21, 2006 and March 21, 2006 Office actions, Applicants also respectfully submit that claims 1-20 are allowable for what they respectively recite.

II. Rejections of the Claims under 35 U.S.C. § 112, First Paragraph

Claims 5-7 and 9-12 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Applicants respectfully traverse.

A. Applicants first respectfully remind the Examiner of the mandated eight-factor analysis for the determination of whether or not any necessary experimentation is undue. The United States Court of Appeals for the Federal Circuit lists these factors as including (A) the breadth of the claims; (B) the nature of the invention; (C) the state of the prior art; (D) the level of one of ordinary skill; (E) the level of predictability in the art; (F) the amount of direction provided by the inventor; (G) the existence of working examples; and (H) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. See MPEP § 2164.01(a). In addition, Applicants respectfully submit that MPEP 2164.01(a) explicitly mandates that “[i]t is **improper** to conclude that a disclosure is not enabling based on an **analysis of only one of the above factors while ignoring one or more of the others.**”

Despite of the mandated eight-factor analysis, Applicants respectfully submit that claim 5 from which claims 6-7 and 9-12 depend is currently amended to expedite the prosecution of the

instant Application, without acquiescence in the cited basis for rejections or prejudice to pursue the original claims in a related application.

B. Applicants respectfully submit that “[l]imitations appearing in the specification but not recited in the claim should not be read into the claims.” MPEP § 2106 citing *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003). Applicants respectfully submit that Fig. 4 and pp. 21-22 merely represent one or some embodiments of the invention and thus should not be read into the claims.

Furthermore, Applicants respectfully submit that the specification provides clear and enabling support for the claimed limitations of claims 5-7 and 9-12 in, for example, p. 3, l. 20 – p. 4, l. 6, p. 12, l. 16 – p. 13, l. 9, p. 13, ll. 10-16, p. 19, l. 19 - p. 20, l. 7 as presented in the previous response to a final Office action. Applicants respectfully note that these passages are provided here for the purpose of illustration and explanation but do not intend to limit the scope of the claimed invention.

In addition, the figure and passages relied upon by the Office action in supporting the grounds for rejections of claims 5-7 and 9-12 merely constitute some embodiments and thus should not be read into the Specification as mandated by MPEP § 2106 and the current patent law jurisprudence.

Nonetheless, Applicants respectfully submit that claims 5-7 and 9-12 are currently amended to expedite the prosecution of this instant Application, without acquiescence in the cited basis for the rejections or prejudice to pursue the original claims in a related application. Applicants respectfully submit that the current amendment to claim 5 renders the rejection under 35 U.S.C. § 112, first paragraph moot.

III. Rejections of Claims under 35 U.S.C. § 101

Claims 17-18 stand rejected under 35 U.S.C. § 101 as allegedly being directed at non-statutory subject matter(s). Applicants respectfully traverse.

Applicants first respectfully submit that claim 17 has recited “said ioput having a conditional output feeding back to a bus” and is thus tied to at least the statutory class of a “machine”. Applicants further respectfully submit that claim 17 also transforms or reduces a particular article to a different state or thing by reciting at least the aforementioned limitation and thus meets the machine-or-transformation test as held by United States Supreme Court in *Diamond v. Diehr*, 450 U.S. 175, 192 (1981) and the United States Court of Appeals for the Federal Circuit in *In re Bilski*, ___ F.3d ___, 2008 WL 4757110, 88 USPQ2d (BNA) 1385 (Fed. Cir. 2008).

Nonetheless, without acquiescence in the cited basis for rejections or prejudice to pursue the original claims 17-18 in a related application, claim 17 is currently amended to clarify the claimed subject matter(s) and now recites at least the limitations of “storing said digital signal input, said analog signal output, or said ioput in a computer storage device”, “simulating the mixed analog/digital system by using a processor configured for solving the mixed analog/digital system . . .”, and “storing the simulation information in the computer storage device or in a second computer storage device” Applicants respectfully submit that the current amendments to claim 17 are believed to have rendered the rejections under 35 U.S.C. § 101 moot.

Therefore, Applicants respectfully request withdrawal of rejections and reconsideration of claims 17-18.

IV. Support for Amendment to the Claims

Applicants respectfully submit that the following figure(s) and passages provide clear support for the amendment to the claims in compliance with the requirements of 35 U.S.C § 112. Applicants further respectfully note that these passages are provided for illustration and explanation purposes, and that other figure(s) and / or passages may also provide support for the amendment to the claims.

For example, Fig. 1 and its corresponding description in p. 10, l. 13 – p. 12, l. 9 describe, in one embodiment, a simulator (100) which comprises a simulation processor (101) and a storage device (102), the latter of which interacts with the simulation processor (101) “for the exchange of stored programs and data, such data including information pertaining to one or more mixed

analog/digital designs for simulation”. P. 10, ll. 20-23. Fig. 1 and its corresponding description also disclose that the simulator (100) also include “standard peripherals including a monitor”. Similarly, p. 7, ll. 19-22 also discloses that “the chip designer builds up a circuit by inputting information at a computer workstation generally having high quality graphics capability so as to display portions of the circuit design as needed.”

CONCLUSION

Based on the foregoing, all claims are believed allowable, and an allowance of the claims is respectfully requested. If the Examiner has any questions or comments, the Examiner is respectfully requested to contact the undersigned at the number listed below.

Applicant(s) hereby explicitly retracts and rescinds any and all of the arguments and disclaimers presented to distinguish the prior art of record during the prosecution of all parent and related application(s)/patent(s), and respectfully requests that the Examiner re-visit the prior art that such arguments and disclaimers were made to avoid.

The Commissioner is authorized to charge any fees due in connection with the filing of this document to Vista IP Law Group's Deposit Account No. **50-1105**, referencing billing number **7010652001**. The Commissioner is authorized to credit any overpayment or to charge any underpayment to Vista IP Law Group's Deposit Account No. **50-1105**, referencing billing number **7010652001**.

Respectfully submitted,

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